UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,642	02/21/2002	Norbert Hofgen	HUBR-1203.2Cont	4195

24972 7590 08/23/2004

FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK, NY 10103-3198

EXAMINER	
MORRIS, PATRICIA L	

ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 08/23/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/081,642	Norbert Hofgen et al
Examiner	**Group Art Unit**
P. Morris	1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 8-26-03.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 21, 26 and 28-32 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 21, 26 and 28-32 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other_____

Office Action Summary

DETAILED ACTION

Claims 21, 26 and 28-32 are under consideration in this application.

Election/Restrictions

The restriction requirement is deemed sound and proper and is hereby maintained. Claims 21, 26 and 28-32 have been examined to the extent readable on the elected subject matter.

Any indication of allowable subject matter is hereby withdrawn in view of the prior art. Ochiai is not in point here. Applicants' demethylation of a methoxy group is well known in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 26 and 28-32 rejected under 35 U.S.C. 102(a) and/or (b) as being anticpated by Rehse et al. (CA 108:75173), Friderichs et al. (CA 83:28056), Allen et al. (CA 66:33303), Itoh et al. (J. Org. Chem, 1997, 62, 5898-5907), Liu et al. (J. Org. Chem. 1997, 62, 74447-7456), von Angerer et al. I (J. Med. Chem. 1984, 27, 1439-1447), II (J. Med. Chem. 1983, 26, 113-116) and Matsuoka et al. (CA 101:23333).

The references disclose the instant process. Note, for example, scheme 2 on page 5900 of Itoh et al. or scheme 7 of Liu et al. or scheme 1 of von Angerer et al. I. Hence, the instant process is deemed to be anticipated by the references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21, 26 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Rehse et al., Friderichs et al., Allen et al., Itoh et al., Liu et al., von Angerer et al. I, II and Matsuoka et al.

The references disclose the instant process. Note, for example, scheme 2 of Itoh et al. or scheme 7 of Liu et al. As here, an methoxy is demethylated to obtain an hydroxy group. The reaction of a specific methoxy group with a demethylating agent does not render the process step

itself patentable, anew; In re Albertson, 141 USPQ 730, which was specifically reaffirmed on the last page of In re Kuehl, 177 USPQ 250.

One having ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product, because he would have expected the analogous starting materials to react similarly. It has been held that application of an old process to a new and analogous material to obtain a result consistent with the teachings of the art would have been obvious to one having ordinary skill.

A long line of cases had that the mere use of a different starting material, whether novel or known, in a conventional process to produce the product one would expect therefrom does not render the process unobvious. In re Surrey et al. (CCPA 1963) 319 F2d 233, 138 USPQ 67; In re Kanter (CCPA 1968) 399 F2d 249, 158 USPQ 331; In re Larsen (CCPA 1961) 292 F2d 531, 130 USPQ 209; In re Albertson (CCPA 1964) 332 F2d 379, 141 USPQ 730; Ex parte Ryland et al. (POBA 1948) 108 USPQ 15; In re Kerkhoven (CCPA 1980) 626 F2d 846, 205 USPQ 1069.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The expression "R^5 is a pyridyl...optionally further subsitute or monosubstituted or polysubstituted" in claims 21 and 28 is employed with no indication of what the substituents really are.

One should be able, from a reading of the claims, determine what that claim does or does not encompass.

The written description is considered inadequate here in the specification. Conception of the intended substituents should not be the role of the reader. Applicants should, in return for a 20 year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35 USC 112, first paragraph. If you (the public) find that it works, I claim it, is not a proper basis of patentability. In re Kirk, 153 USPQ 48, at page 53.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 fails to recite a complete process. The term converting fails to describe the process. Demethylation is an obvious process under 35 USC 103. Claim 21 fails to recite the reaction conditions, *i.e.*, reactants, reagents, temperature, solvents, etc.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Morris
Primary Examiner
Art Unit 1625

plm
August 19, 2004